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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/905,354  | 07/13/2001  | Li Wensheng          | OAC-013             | 3811             |
| 959   | 7590        | 10/13/2004           | EXAMINER            |                  |
| LAHIVE & COCKFIELD, LLP.<br>28 STATE STREET<br>BOSTON, MA 02109 |             |                      | TRAN, NGHI V        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2151                |                  |

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/905,354

Applicant(s)

WENSHENG, LI

Examiner

Nghi V Tran

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the translation of Japan 2001-068522 has a different inventor, Ri Fumio.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The disclosure is objected to because of the following informalities:

Line 16, page 7, the phrase "The GCI program" (emphasis added) appears to be a typo error for --The CGI program--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleskes, U.S. Patent Number 6,529,910.

Taking claim 1 as an exemplary claim, Fleskes teaches a system for managing information having a member database for storing identification codes for a plurality of members and information on respective members, and a web server associated with the member database, said web server being programmed to:

- transmit to a user, in response to access from the user via the Internet, an HTML document that has an input field for said identification code (steps 1020, 1030, 1040, and 1050 of figure 3 and figure 87),
- responsive to receipt of said identification code from the user, search the member database using said identification code as a key to retrieve information on a member corresponding to said identification code (step 1060 of figure 3, column 8, lines 35-38, and column 9, lines 55-59), and
- transmit said information to the user ("YES" side of step 1060 of figure 3).

With respect to claim 2, Fleskes further teaches the web server includes a database program for use by a user with a user computer, said web server being further programmed to: transmit to a user, in response to access of the user, an HTML document including a button or an input field for requesting downloading of said database program, and transmit the database program to the user responsive to receipt of a request from the user (column 8 line 44-55 and button "login" of figure 88).

6. Claims 5-6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Friedman et al., U.S. Patent Application Publication 20030208556 (hereinafter Friedman).

Taking claim 5 as an exemplary claim, Friedman teaches a computer executable program adapted for use by a user in conjunction with a system having a member database for storing identification codes for a plurality of members and information on respective members, and a web server associated with said member database, said web server being configured to search said member database in response to a user access via the Internet to retrieve information on a member and transmit said information to a user, said computer executable program having the functions of:

- storing in an address book said information on the member downloaded from said web server (items 270 and 280 of figure 2; and page 5, paragraph 0063),
- displaying on a screen of a computer an input page having a text block for producing a message part of a card and a picture block for pasting an image (item 600 of figures 6A-K; column 7, paragraph 0072 and 0075; and page 9, paragraph 0090), and
- setting a destination of the card based on data contained in said address book (page 9, paragraph 0091 and paragraph 0096).

With respect to claim 6, Friedman further teaches the computer executable program is transmitted from said web server to a user in response to a user request (see abstract; item 740 of figure 7B; and page 5, paragraph 0056).

Art Unit: 2151

With respect to claim 8, Friedman further teaches the program further has a function of transmitting said card to a destination by e-mail by clicking a transmission button (page 4, paragraph 0051; page 7, paragraph 007; and page 10, paragraphs 0098-0099).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleskes as applied to claim 1 above, and further in view of Friedman.

With respect to claim 3, Fleskes fails to teach the web server includes a database for producing business cards. On the other hand, Friedman teaches the web server includes a database for producing business cards, and is programmed to: transmit to a user, in response to access from a user, an HTML document carrying a page that includes a template and an input field for producing business cards, and accept orders for printing business cards, with data on a member being read out from the member database (see abstract; page 5, paragraph 0064; and figures 6A-K). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Fleskes in view of Friedman by producing business cards online with the user profile. The motivation for doing so would have been obvious

Art Unit: 2151

because creating or producing business cards with user profile is saving time by not filling out the user information.

With respect to claim 4, Fleskes fails to teach the web server transmits information to user via e-mail. On the other hand, Friedman discloses the web server comprises recording means for recording an e-mail address of a user who has downloaded information on a member, said web server being programmed to: refer to said recording means when a change is made to data on the member, and transmit information on such change by e-mail to the user who has downloaded the data on the member (page 4, paragraph 0051; page 7, paragraph 007; and page 10, paragraphs 0098-0099). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Fleskes in view of Friedman by sending e-mail to the user. The motivation for doing so would have been obvious because sending e-mail to user is to enable a user to securely perform a particular type of transaction such as confirm a change of the data on the member, confirm an order, or etc.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman as applied to claims 5-6 above, and further in view of Grasso et al., U.S. Patent Number 5,892,909 (hereinafter Grasso).

With respect to claim 7, Friedman fails to teach name and address data in CSV format. On the other hand, teaches the program is configured so that name and address data in the CSV format can be imported or exported (column 14, lines 28-37). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Friedman in view of Grasso by importing the data in CSV

Art Unit: 2151

format. The motivation for doing so would have been obvious because "the import capabilities allow field matching to map external database information to the system's internal address book information" that can be easily understood by any database.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Administration and search and replace of computerized prepress," by Jecha et al., U.S. Patent Application Publication 2002/0059235.
- b. "Communication control device including business card database with associated business card agents for controlling communicated electronic mail between user and card provider," by Moon et al., U.S. Patent Number 6,157,954.
- c. "System and method for providing secure URL-based access to private resources," by Linden et al., U.S. Patent Number 6,360,254.
- d. "Print on demand virtual builder," by Blumberg et al., U.S. Patent Application Publication 2003/0140315.
- e. "System and method for preparing customized printed products over a communications network," by Arledge, Jr. et al., U.S. Patent Number 6,535,294.
- f. "Image partitioning to avoid overlap transmission," by Li et al., U.S. Patent Number 6,625,309.
- g. "Electronic business cards," by Beaton et al., U.S. Patent Number 6,442,263.



h. "Subscription access system for use with an untrusted network," by Gregg et al., U.S. Patent Application Publication 2002/0002688.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi V Tran  
Examiner  
Art Unit 2151

NT

  
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PRIMARY EXAMINER